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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,732	07/25/2001	Joseph Atabekov	0933-0169P	5590

2292 7590 09/29/2004

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EXAMINER

LAMBERTSON, DAVID A

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Examiner-Initiated Interview Summary	Application No. 09/911,732	Applicant(s) ATABEKOV ET AL.	
	Examiner David A. Lambertson	Art Unit 1636	

All Participants:

Status of Application: _____

(1) David A. Lambertson.

(3) Dr. Hartz (European Representation).

(2) MaryAnne Armstrong.

(4) Dr. Blodig (European Representation).

Date of Interview: 15 September 2004

Time: _____

Type of Interview:

- ☒ Telephonic
☐ Video Conference
☐ Personal (Copy given to: ☐ Applicant ☐ Applicant's representative)

Exhibit Shown or Demonstrated: ☐ Yes ☒ No

If Yes, provide a brief description:

Part I.

Rejection(s) discussed:

35 USC § 112, first paragraph Written Description and Enablement.

Claims discussed:

All claims

Prior art documents discussed:

None

Part II.

SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:

See Continuation Sheet

Part III.

- ☐ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability.
☒ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.

(Examiner/SPE Signature)

(Applicant/Applicant's Representative Signature – if appropriate)

Continuation of Substance of Interview including description of the general nature of what was discussed: Applicant's representatives contacted the Office concerning potential amendments to the claims, made to obviate the rejections set forth in the previous Office Actions; prospective claim amendments were provided for review prior to the interview. It was recommended to Applicant's representatives that, in order to overcome the rejections under 35 USC § 112, first paragraph, they should address how the Ivanov et al. reference was an innaccurate reflection of the art, in addition to the claim amendments. It was also recommended that Applicant specifically indicate where in the specification there was support for a structure-function relationship across the claimed genus of IRES elements. It was discussed that the structures set forth in Figures 1(B-H) might represent such a structure-function relationship; however, this was dependent on what the figures actually taught in a structure-function sense across the claimed genus (i.e., it is recommended that Applicant explicitly explain how the figures represent a structure-function relationship across the claimed genus).

Formal issues were also discussed. The Office indicated that, should Applicant pursue rejoinder of the method claims, they would be subject to potential rejections under 35 USC § 112, first and second paragraphs, pending their initial examination; this is irrespective of whether the method claims are commensurate in scope with the claimed product, should the product be found allowable. It was also indicated that the figures appear to have sequences that are not in compliance with 37 CFR § 1.821-1.825, and that the deficiency must be remedied. As it concerned the potential amendments provided, Applicant's representatives were advised to be aware of potential 35 USC § 112, second and fourth paragraph issues regarding dependent claims. It was also indicated that a new search and consideration of the claims would likely be required concerning the potential amendments provided to the Office prior to the interview.

Finally, it was indicated that final approval of any claim amendments prior to allowance would require a review and approval by a primary examiner.



JAMES KETTER
PRIMARY EXAMINER